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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,078	09/11/2000	Cary Lee Bates	ROC920000078US1	4594
24033	7590	05/17/2005	EXAMINER	
KONRAD RAYNES & VICTOR, LLP 315 S. BEVERLY DRIVE # 210 BEVERLY HILLS, CA 90212			HILLERY, NATHAN	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,078

Applicant(s)

BATES ET AL.

Examiner

Nathan Hillery

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15-25 and 29-39 is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 26-28 and 40-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-25 and 29-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: RCE filed on 3/8/05.
2. Claims 1 – 11, 15 – 25, and 29 – 39 are pending in the case. Claims 1, 15, and 29 are independent. Claims 12 – 14, 26 – 28, and 40 – 42 have been withdrawn from examination at this time.
3. The rejection of claims 1 – 11, 15 – 25, and 29 – 39 under 35 U.S.C. 103(a) as being unpatentable has been withdrawn as necessitated by amendment and applicant's arguments.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/8/05 has been entered.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 6, 8 – 11, 15 – 20, 22 – 25, and 29 – 34, 36 – 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courter et al. (Microsoft Office 2000) [as previously cited] and further in view Pandit (US 5859636 A).

7. **Regarding independent claim 1**, Courter et al. illustrate in Figure 19.2 on p 444 **(i) accessing contact information including contact phrases; and (ii) searching the contact information to determine if the scanned contact phrase matches contact phrases in the searched contact information**. Courter et al. do not explicitly teach **scanning...**, etc., However, Pandit teaches that *conventional programs that provide any text recognition and operation capabilities, i.e., find and replace, etc. require the text to be embedded in, for example, a document created by the program. This invention does not require that the text be embedded in any document created on or by a particular application program. Any text appearing on a video monitor can be operated on by the invention, whether the text is within an EMail message, World-Wide Web site, created by a word processing or database program, etc. Furthermore, by using parsers as the subroutines for detecting certain types of data, the invention is able to recognize data appearing in a number of formats, rather than a single defined format* (Column 5, lines 12 – 23), which provide for **scanning and parsing words in the text; for each set of one or more scanned and parsed words, determining whether one or more words form a scanned contact phrase providing information to identify or address a person or entity**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disclosure of Courter et al. with that of Pandit since Pandit also teaches that *an embodiment of pulled-down EMail menu 19 is*

shown in FIG. 1d. Included in pulled-down Email menu 19 are such programs as a writable Email or general address book database and an EMail template and transmitting program, preferably automatically addressed with the accented address recognized in the text, etc. Any other program related to EMail sending or address storage may be included as within the scope of this invention (Column 2, lines 56 – 63). Furthermore the combined invention, thus, provide that **upon determining that one or more words form a scanned contact phrase, performing (i) accessing contact information including contact phrases; and (ii) searching the contact information to determine if the scanned contact phrase matches contact phrases in the searched contact information; and upon determining that one or more words do not form a scanned contact phrase, performing said scanned contact phrase determining with respect to other words of said text** (Courter et al., p 444, Figure 19.2; Pandit, Column 2, lines 56 – 63).

8. **Regarding dependent claim 2**, Pandit teaches that *as shown in FIGS. 1c-1f, the invention is not limited to the recognition of dates in text and preferred embodiments of the invention can recognize e-mail addresses and telephone numbers. In fact, there is no limit on the type of text which can be recognized by the invention and additional embodiments can recognize such classes of text as Uniform Resource Locators, nouns, verbs, names, street addresses, etc. (Column 2, line 25 – 32), which provides that the contact phrases comprise one of a name, phone number, street address, e-mail address, and URL; and that the invention preferably includes as default operations such programs as spell-checkers, grammar-checkers, a thesaurus, a dictionary,*

execution of an EMail program to transmit the text, programs to store the text and any other programs relating to words in general (Column 3, lines 18 – 23), which provides for **further comprising spell checking words determined not to form a scanned contact phrase**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disclosure of Courter et al. with that of Pandit since Pandit also teaches that *an embodiment of pulled-down EMail menu 19 is shown in FIG. 1d. Included in pulled-down Email menu 19 are such programs as a writable Email or general address book database and an EMail template and transmitting program, preferably automatically addressed with the accented address recognized in the text, etc. Any other program related to EMail sending or address storage may be included as within the scope of this invention* (Column 2, lines 56 – 63).

9. **Regarding dependent claim 3**, the claim incorporates substantially similar subject matter as claims 4 – 5, and is rejected along the same rationale.

10. **Regarding dependent claims 4 – 5**, Courter et al. teach that *Outlook uses the Check Names dialog box to clarify an incomplete or erroneous e-mail address* (page 407, caption under Figure 18.5). Further, Courter et al. illustrate a dialog box in Figure 18.5, which provide for **displaying a graphical box for one scanned contact phrase that does not match contact phrases in the contact information, wherein the user is capable of using the displayed graphical box to accept the scanned contact phrase or select another contact phrase to substitute for the scanned contact phrase; determining at least one contact phrase, in the contact information that is similar, but not identical, to the scanned contact phrase if the scanned contact**

phrase does not match one contact phrase in the contact information; and displaying the determined contact phrases in the displayed graphical box, wherein the user is capable of using the displayed graphical box to select one displayed contact phrase to substitute for the scanned contact phrase.

11. **Regarding dependent claim 6**, Courter et al. teach that *an address book is a list of names you can select addresses from. You may have only one address book* (page 444, bottom) and that *the Outlook Address Book automatically contains the entries in your Contacts folder ...* (page 444, last paragraph), which provide that **the contact information comprises contact records for different contacts in a computer readable address book, wherein each contact record is capable of including multiple different contact phrases for one contact.**

12. **Regarding dependent claim 8**, Courter et al. teach that *there are three ways to enter e-mail addresses ... by searching for the person's e-mail address with a directory service* (page 443, last paragraph) and that *the directory could be ... on a public directory service you access via the Internet, such as Four11 or Bigfoot. You use directory services when you know a person's name, but don't have their e-mail address* (page 446, third block paragraph), which provide that **the scanned contact phrase comprises a name or contact address; for submitting a search request over the Internet to an Internet directory for the scanned contact phrase; and for receiving information indicating that there is no match for the scanned contact phrase in the Internet directory or that there is a match.**

13. **Regarding dependent claim 9**, Courter et al. teach that *Outlook uses the Check Names dialog box to clarify an incomplete or erroneous e-mail address* (page 407, caption under Figure 18.5). Further, Courter et al. illustrate a dialog box in Figure 18.5, which provide for **adding the scanned contact phrase to the contact information if the scanned contact phrase does not match one contact phrase in the contact information.**

14. **Regarding dependent claim 10**, Courter et al. do not explicitly teach **buffering**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to do so since the invention of Courter et al. has the ability to store *up to 19 different telephone numbers for a contact* (page 406, last line of second block) formatted similarly; thus, the skilled artisan would be able to save resources and memory. Further, Courter et al. do teach to *just enter the digits in the telephone number ... when you move out of the text box, Outlook will automatically format the digits, adding parentheses, spaces, and hyphens. If you enter a seven-digit telephone number, Outlook assumes the phone number is local, and adds your area code to the number* (page 406, third and fourth blocks), which provides for **buffering contact phrases of a same type of contact information; determining whether the buffered contact phrases of the same type use consistent syntax; and notifying a user of inconsistencies in the syntax for the buffered contact phrases.**

15. **Regarding dependent claim 11**, Courter et al. teach that *when you enter a world Wide Web URL in the Web Page Address text box, enter the resource name ... and when you leave the text box, Outlook will automatically add http:// to the beginning*

of the URL (page 407, last block), which provides that **the scanned contact phrases include at least one URL address; determining whether each scanned URL contact phrase uses a correct URL syntax; and notifying the user of incorrect syntax for at least one of the scanned URL contact phrases.**

16. **Regarding independent claim 15**, the claim incorporates substantially similar subject matter as claim 1, and is rejected under the same rationale.

17. **Regarding independent claim 16**, the claim incorporates substantially similar subject matter as claim 2, and is rejected under the same rationale.

18. **Regarding independent claim 17**, the claim incorporates substantially similar subject matter as claim 3, and is rejected under the same rationale.

19. **Regarding independent claim 18**, the claim incorporates substantially similar subject matter as claim 4, and is rejected under the same rationale.

20. **Regarding independent claim 19**, the claim incorporates substantially similar subject matter as claim 5, and is rejected under the same rationale.

21. **Regarding independent claim 20**, the claim incorporates substantially similar subject matter as claim 6, and is rejected under the same rationale.

22. **Regarding independent claim 22**, the claim incorporates substantially similar subject matter as claim 8, and is rejected under the same rationale.

23. **Regarding independent claim 23**, the claim incorporates substantially similar subject matter as claim 9, and is rejected under the same rationale.

24. **Regarding independent claim 24**, the claim incorporates substantially similar subject matter as claim 10, and is rejected under the same rationale.

25. **Regarding independent claim 25**, the claim incorporates substantially similar subject matter as claim 11, and is rejected under the same rationale.
26. **Regarding independent claim 29**, the claim incorporates substantially similar subject matter as claim 1, and is rejected under the same rationale.
27. **Regarding independent claim 30**, the claim incorporates substantially similar subject matter as claim 2, and is rejected under the same rationale.
28. **Regarding independent claim 31**, the claim incorporates substantially similar subject matter as claim 3, and is rejected under the same rationale.
29. **Regarding independent claim 32**, the claim incorporates substantially similar subject matter as claim 4, and is rejected under the same rationale.
30. **Regarding independent claim 33**, the claim incorporates substantially similar subject matter as claim 5, and is rejected under the same rationale.
31. **Regarding independent claim 34**, the claim incorporates substantially similar subject matter as claim 6, and is rejected under the same rationale.
32. **Regarding independent claim 36**, the claim incorporates substantially similar subject matter as claim 8, and is rejected under the same rationale.
33. **Regarding independent claim 37**, the claim incorporates substantially similar subject matter as claim 9, and is rejected under the same rationale.
34. **Regarding independent claim 38**, the claim incorporates substantially similar subject matter as claim 10, and is rejected under the same rationale.
35. **Regarding independent claim 39**, the claim incorporates substantially similar subject matter as claim 11, and is rejected under the same rationale.

36. Claims 7, 21 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courter et al. (Microsoft Office 2000) [as previously cited] and Pandit (US 5859636 A) as applied to claims 1 – 6, 8 – 11, 15 – 20, 22 – 25, and 29 – 34, 36 – 39 above, and further in view of Nielson (US 5907680 A).

37. **Regarding dependent claim 7**, Courter et al. nor Pandit explicitly teach **determining whether the scanned URL, contact phrase addresses an accessible page on the Internet; and presenting information indicating whether the scanned URL addresses an accessible page on the Internet**. However, Nielson teaches that *if the URL was manually entered by the user (206) then the client side component of the invention performs a spelling check on the protocol and domain-name portion of the URL (208) and creates a list of potentially valid URLs (210). If the created list is not empty (212) then the list is displayed to the user in a hypertext format (214). The user may then select one of the generated URLs (216) or cancel the operation (216)* (Column 6, lines 14 – 21), which provide for **determining whether the scanned URL, contact phrase addresses an accessible page on the Internet; and presenting information indicating whether the scanned URL addresses an accessible page on the Internet**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disclosure of Courter et al. and the invention of Pandit with the invention of Nielson because such a combination would provide the readers of Courter et al. and the users of Pandit with *software that provides a user who manually*

enters a URL with a sophisticated method for spell checking the URL to increase the probability of finding the desired WWW in a timely fashion (Column 2, lines 14 – 18).

38. **Regarding independent claim 21**, the claim incorporates substantially similar subject matter as claim 7, and is rejected under the same rationale.

39. **Regarding independent claim 35**, the claim incorporates substantially similar subject matter as claim 7, and is rejected under the same rationale.

Response to Arguments

40. Applicant's arguments with respect to claims 1 – 11, 15 – 25, and 29 – 39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH



JOSEPH FEILD
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